



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,456	03/23/2004	Taiji Nishi	250858US2	1229
22850 7590 12/17/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER RAMDHANE, BOBBY				
ART UNIT 1797		PAPER NUMBER		
NOTIFICATION DATE 12/17/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/806,456	Applicant(s) NISHI ET AL.
Examiner BOBBY RAMDHANIE	Art Unit 1797

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 November 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires ___ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 30 November 2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
b) ☐ They raise the issue of new matter (see NOTE below);
c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-19, 36 and 37.
Claim(s) withdrawn from consideration: 20-34.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: (Please See Continuation Sheet).
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Walter D. Griffin/
Supervisory Patent Examiner, Art Unit 1797

Applicants' arguments are primarily toward the combination of Wang et al in view of Chou et al. Applicants argue that, "Wang et al does not disclose or suggest that the photo resist is made of multiple layers having different solubilities." Applicants further argue that Chou et al does not cure the deficiency of Wang et al.

The Examiner has provided a 103(a) rejection towards Applicants' alleged invention. The Examiner has acknowledged the fact that Wang et al does not teach nor disclose that the photo resist is not made of multiple layers having different solubilities (Please see Office Action mailed on 05/29/2009).

Wang does however disclose that the invention using a single resist having a solubility is used for the resist pattern (See Wang et al Figures 21A-E).

Wang et al also discloses that the resist can be formed by a number of methods including coating, dip coating, roll coating, through one or more processing steps AND that the resist may be either a positive or negative resist (See Wang et al, Column 3 lines 45-56). In one aspect, Applicants' alleged invention may be viewed as merely duplicating a part (or in this case, a step) and is obvious over Wang et al, alone (This rejection was not made in the Office Action mailed on 05/29/2009). One of ordinary skill in the art would recognize that positive and negative photo resist have different solubilities and would be able to develop the layers accordingly).

Chou et al discloses the method of developing different layers of a photo resist to form a resist pattern (Please see Chou et al & Office Action mailed on 05/19/2009). One of ordinary skill in the art would seek Chou et al and combine the references for a number of different motivating factors. The most evident one is that because Wang et al clearly states that the photo resist may be either positive or negative since both disclose that the resists are photo resists. Second, Wang et al discloses that the method is related to products of the semiconductor/electronics industry (See Column 4 lines 47-56). One of ordinary skill in the electronics industry would seek out Chou et al because Chou et al explicitly discloses that the method is generally related to integrated-circuit (LC) chip packaging industry, semiconductor wafer technology, and "for forming patterns on substrates (analogous art, emphasis added)."

The reasoning and rationale to combine these references is reasonable and is maintained. The amendment submitted on 11/30/2009, is entered. The claims would be rejected in the same manner as described above and in the Office Action mailed on 05/29/2009.